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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,708	12/17/2003	Motoomi Arakawa	0020-5209P	5696

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EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/736,708

Applicant(s)

ARAKAWA ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/14/05 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicants' amendment filed on July 14, 2005 was received. Claims 2 and 6-7 are deleted. Claims 1, 3-5 and 8-10 are amended. Claim 16 is added.

Now, Claims 1, 3-5 and 8-16 are pending.

2. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 0305) is/are removed.

3. Applicants should notice that the foreign priority document, JP 2002-365499, has not been received.

4. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 0305).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly

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connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 3-5 and 8-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an E segment having Formulae (1)-(4) wherein E¹ is a segment of polycarbonate, polyarylate or polysulfone ([0033]-[0035] and [0037]), does not reasonably provide enablement for an E segment having Formulae (1)-(4) wherein E¹ is any polycondensation segment. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

Claim Rejections - 35 USC § 102 and 103

7. Rejection of Claims 1, 3-5, 8, 10, 13 and 15 under 35 USC 102(b) as being anticipated by Plueddemann (US 3 567 497) is maintained because the rejection is adequately set forth in paragraph 6 of Paper No. 0305. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below. Note that the instant claims still encompass the rejected claimed embodiments set forth in the previous Office action. Furthermore, Applicants should notice that Claim 9 was not rejected by

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Plueddemann as indicated in the previous Office action, while Claim 10 is properly rejected because no macropolymerization initiator is required.

8. Rejection of Claims 1, 3-5, 8, 10, 13 and 15 under 35 USC 102(b) as being anticipated by GB405 (GB 735 405) is maintained because the rejection is adequately set forth in paragraph 7 of Paper No. 0305. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below. Note that the instant claims still encompass the rejected claimed embodiments set forth in the previous Office action.

9. Rejection of Claims 1, 3, 5, 8, 10, 13 and 15 under 35 USC 102(b) as being anticipated by Mitsutaka (GB 2 303 632) is maintained because the rejection is adequately set forth in paragraph 8 of Paper No. 0305. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below. It is noted that the last paragraph of page 12 in Applicants' Remarks, there appears a typographical error, i.e., "GB 735 405" should reads "GB 2 303 632". Note that the instant claims still encompass the rejected claimed embodiments set forth in the previous Office action. Furthermore,

Applicants should notice that Claim 9 was not rejected by GB405 as indicated in the previous Office action, while Claim 10 is properly rejected because no macropolymerization initiator is required.

10. Rejection of Claim 1, 3-5, 8-9 and 11-15 under 35 USC 103(a) as being unpatentable over Arakawa (US 6 103 854) in view of Bigley (US 5 406 641) as evidenced by Odian (Principles of Polymerization, 2nd Ed., Wiley-Interscience, 1981, pages 226-242) is maintained because the rejection is adequately set forth in paragraph 10 of Paper No. 0305. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below. Note that the instant claims still encompass the rejected claimed embodiments set forth in the previous Office action. For Applicants' argument in Remarks (page 14, 1st and 2nd paragraphs), it is noted that in the previous Office action (Paper No. 0305)(page 12, line 4 from bottom and page 13, line 5), there is a typographical error, "Arakawa" should read "Bigley". Examiner apologizes for causing any inconvenience. It is obviously not Examiner's intention to indicate that Arakawa is a non-analogous art because whether clearly Arakawa is a non-analogous art or not with respect to the present invention is irrelevant. Instead, Examiner meant that Bigley is a non-analogous art with respect to Arakawa. For

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Applicants' argument (Remarks, page 14, last paragraph), note that Claims 10 and 14 do not need a macropolymerization initiator.

Allowable Subject Matter

11. Claim 16 is allowed.

12. The following is an examiner's statement of reasons for allowance:

None of the above references, taken alone or in combination, teaches or fairly suggest a copolymer having the specific E segment.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date

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of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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klp

September 16, 2005

A handwritten signature in black ink, appearing to read 'Kuo-Liang Peng', written in a cursive style.

Kuo-Liang Peng
Primary Examiner
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